Office Supreme Court, U.S.
FILED
JUN 17 1964
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1963

No. 1050

ERNST JOHAN JENS HENRIKSEN AND
W. A. SHEAFFER PEN COMPANY,
Petitioners,

vs.

CORY CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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W. A. SHEAFFER PEN COMPANY,
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CORY CORPORATION,
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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

There are no special or important reasons why certiorari should be granted in the present case. The Court of Appeals from whose decision review is sought, correctly applied the well established rule of law that a patentee having asserted in the Patent Office that his claims have one particular meaning in order to get them allowed, cannot take the position in court that the claims have a different and broader meaning. In arriving at this decision, the Court of Appeals relied upon principles established by this Court as early as 1900 in the case of *Hubbell* v. *United States,* 179 U. S. 77.

There is no conflict between the decision of the Court of Appeals below and the decision of the Court of Appeals

for the Ninth Circuit in the case of *Engelhard Industries, Inc.* v. *Research Instrument Corp.*, 324 F. 2d 347, as claimed by petitioners. In both decisions the Courts of Appeal recognize the rule that a file wrapper estoppel can arise out of actions taken by the patentee in the Patent Office in order to get his claims allowed, including the election of species.

The questions presented in the petition are based on a misreading of the facts in this case. Under the true facts of the case the questions disappear.

RESTATEMENT OF THE CASE.

Petitioners incorrectly represent (Pet. 5) that Henriksen was the originator of the concededly simple idea of using, in a ball point pen having a large diameter ink reservoir, a follower or lid on top of the ink column in order to keep the ink from running out when the pen is inverted and also to keep the ink from contact with the air. Such a construction using a cylindrical body of aluminum as the follower, is shown in the prior art Huenergardt patent 2,426,453 (Rec. 313). The Huenergardt patent is not discussed in the petition, although during the period from 1945 to 1949 about 150 million pens having the Huenergardt construction were sold in this country and abroad (Rec. 78-82).

In his application as originally filed, Henriksen stated that his lid or follower could take many forms, and his claims covered the use of followers broadly as well as various kinds of followers (Rec. 173, 180-187).

When the Huenergardt patent was cited by the Patent Office, Rule 41 requiring Henriksen to elect a species for prosecution was also cited (Rec. 194-5). Thereupon, Henriksen added three new claims, 28, 29 and 30 (Rec. 196-7). Claim 28 described the follower as being "a viscous mass",

claim 29 described it as "a layer of a greasy substance", and claim 30 described it as "a layer of a pulpy mass". In filing the three additional claims Henriksen stated that claim 28 was "indicative" of the species of the invention as then elected, and pointed out to the Patent Office that:

> "Claims 29 and 30 are directed to the species of a greasy substance and pulpy mass, **respectively**, as species to which claim 28 is generic." (Rec. 198.)*

Henriksen in the same amendment went on to state that in the event his "viscous" claim was not allowable, he elected the "pulpy" species, saying:

> "Applicant **further elects as a single species** for the lid a lid of **pulpy mass** in the event that no generic claim should be found allowable." (Rec. 198.)

It is undeniably clear as pointed out by the Court of Appeals below (Pet. 5a-6a), that Henriksen thus defined "pulpy" and "greasy" followers as separate and independent species under Rule 41, and different from each other. All of the claims in the Henriksen patent require the follower to be pulpy, whereas respondent's follower is common lubricating grease.

In the next Patent Office action the examiner rejected generic claim 28** as unpatentable over Huenergardt and other prior art (Rec. 200), and also stated:

> "Claim 29, **specific** to grease, and claim 30, **specific** to pulp, are rejected for reasons applied to claim 28." (*Ibid.*)

After Henriksen had re-argued these claims (Rec. 201-4), the examiner rejected them all again (Rec. 205-6), citing

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* All emphasis ours unless otherwise indicated.

** Petitioners incorrectly refer (Pet. 7, 8, 9) to claim 9 as "defining the follower generically", and to claims 28-30 as all "species" claims (Pet. 9, 18). Claim 9 was limited, as claims 28-30 were not, to a pen structure having an air tight chamber and a driving pressure on the follower (Rec. 182).

Martin patent 2,495,013 (Rec. 319). Martin discloses a ball point pen wherein the follower was a "highly viscous or pasty" slug of ink (Rec. 322). Furthermore, Martin stated that the ink could be of the types shown in several Biro patents, and the inks of those patents were greasy.*

After the Patent Office cited the Martin patent Henriksen cancelled all of his prior claims and presented claim 31 wherein the follower was described as a "substantially viscous **pulpy** mass" (Rec. 207-209). In substituting claim 31 for all of the claims theretofore in the case, Henriksen stated, in support of alleged patentability thereof over Martin:

> "Such structure is believed **entirely different** from that of applicant as now set forth in new claim 31 **which is drawn to the elected species.**
>
> "As soon as this claim is considered allowable, applicant will **in accordance with his election made,** change Fig. 2 to show a **follower of pulpy mass** for the follower 6 as now indicated in Fig. 2." (Rec. 208-209.)

The foregoing action taken by Henriksen, and his acquiescence in the issuance of his patent with all claims restricted to the "pulpy" follower, establishes a clear basis for the determination by the Court of Appeals that

> "Henriksen clearly abandoned a 'greasy' follower and limited his patent to the 'elected species' where the follower is 'pulpy.'" (Pet. 6a.)

Even with claim 31 limited to a pulpy follower, the examiner refused to allow it (Rec. 210). On Henriksen's appeal to the Board of Appeals, only the Martin patent was relied on by the examiner in arguing that **"the elected species 'pulpy mass'** follower" was unpatentable

* The Biro patents appeared in the record below as part of the 317 page printed Appendix filed by the petitioners (then Plaintiffs-Appellees). This Appendix, however, was omitted by the petitioners from the record filed in this Court, although Rule 21(3) would seem to require it. See also Rule 22(3).

(Rec. 225). The Board allowed the claim on the ground that Martin failed to show a large capacity reservoir (Rec. 233). The Huenergardt patent, of course, does show a large capacity reservoir but the examiner had failed to cite this patent to the Board on the appeal.

After the decision of the Board of Appeals, the specification was revised, and in its discussion of the follower stated among other things that it could consist of

> "a semi-pasty mass of a composition of paraffin (as a fatty substance or derivative of petroleum and other mineral oils), **or** of wax, **or** of a viscous pulpy mass . . ." (Rec. 237-238.)

Petitioners' argument (Pet. 10, 19), that this latter statement defined "pulpy" to include the other materials described, completely overlooks the disjunctive "or." Thus, anyone looking at this language in the specification for a definition of "viscous pulpy mass" as used in the claims, would see only that it was something other than wax or paraffin compositions. Compare Rec. 225. Henriksen had earlier stated that nonelected divisional subject matter was being retained in the case (Rec. 198) and perhaps the examiner viewed these other compositions (if he noted their presence at all) as pertinent to the "divisional applications on other species" Henriksen said he might file, and which he later did file.* In any event, petitioners' assertion (Pet. 10, 18-19, 24) that the examiner "agreed" with Henriksen that the revised specification changed the prior scope of the allowed claims is palpably wrong.

Also wrong are petitioners' assertions (Pet. 10-11, 18-21, 24) that the scope of the elected "pulpy mass" claims was changed by Henriksen's last minute remarks regarding followers of "cup-grease" and thickened "mineral oil" (Rec. 249), and that the examiner "approved",

* Such an application was filed on April 8, 1954 (Rec. 114).

"agreed to" and "officially accepted" this alleged change. The remarks referred to appear in an amendment filed March 4, 1954 following an interview with the examiner. We do not know what attempts Henriksen's attorney may have made at this interview to try to get the examiner's approval to a proposed claim which was not restricted to the previously elected "pulpy" species. But, clearly, he was unsuccessful since new claim 34 was also so restricted. Henriksen's remarks do **not** say that cup-grease and thickened mineral oil are "pulpy mass" followers, merely that they are types of "viscous" followers. This is entirely consistent with the position he took when he originally introduced the generic "viscous" claim and the independent "greasy" and "pulpy" species claims. The examiner undoubtedly so viewed the remarks. In any event, the law is clear as noted *infra*, p. 9, that such remarks by an applicant, unaccompanied by appropriate changes in the wording of his claims, cannot affect a prior disclaimer. Henriksen **did not** change the elected "pulpy mass" restriction in his claims and **did not** appeal from the rejection of claims to the different "greasy substance" species and to "viscous" followers generally.

The foregoing clearly refutes the erroneous factual basis for petitioners' "questions presented" and "reasons for granting the writ". The election by Henriksen was not a "provisional, contingent" one which was later "withdrawn, modified or annulled". And the prosecution history subsequent to that election not only fails to reveal any "agreement" between Henriksen and the examiner to change the elected "pulpy mass" limitation in his claims, but instead confirms and reinforces that limitation. The Court of Appeals did not ignore that subsequent history, it merely interpreted it correctly.

NO REASON EXISTS HERE FOR GRANTING CERTIORARI.

When the controlling facts of this case are stated accurately, it is readily seen that the only real question presented here is whether petitioners, defeated below, are entitled to another hearing on the merits of their case. But as stated in *Magnum Co.* v. *Coty*, 262 U. S. 159, 163 (1923), certiorari jurisdiction

> "was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing".

Also, when the controlling facts here are stated accurately, it is readily seen that the Court of Appeals holding of non-infringement was correct, under well established principles of law. See e.g., *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 443-444 (1926), *Smith* v. *Magic City Club*, 282 U. S. 784, 789-790 (1931), *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 220-221 (1940), *Exhibit Supply Co.* v. *Ace Corp.*, 315 U. S. U. S. 126, 136-137 (1942).

Furthermore, on the facts here *none* of the cases cited in the petition supports a holding contrary to that below. Indeed, in many of those cases, the courts, on similar facts, held to the same effect, enouncing principles identical to, or in harmony with, those applied in this case.* Cases cited by petitioners dealing with alleged constitu-

* See, in addition to the cases cited at Pet. 14, *Leggett* v. *Avery*, 101 U. S. 256, 259-260 (1879), *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, 429 (1894), both cited at Pet. 18, *I. T. S. Co.* v. *Essex Co.*, 272 U. S. 429, 443-444 (1926), *Hookless Fastener Co.* v. *G. E. Prentice Mfg. Co.*, 68 F. 2d 848, 850 (2 Cir. 1934), *Del Francia* v. *Stanthony Corporation*, 278 F. 2d 745, 747 (9 Cir. 1960), *Tschappat* v. *Hinderliter Tool Co.*, 98 F. 2d 994, 998 (10 Cir. 1938), *Zenith Radio Corp.* v. *Lehman*, 121 F. Supp 69, 73 (S. D. N. Y. 1954), affirmed per curiam 217 F. 2d 954 (2 Cir. 1955), *Directoplate Corp.* v. *Donaldson Lithographing Co.*, 51 F. 2d 199, 202 (6 Cir. 1931), all cited at Pet. 20-21, *Dwight & Lloyd Sintering Co.* v. *Greenawalt*, 27 F. 2d 823, 832 (2 Cir. 1928), cited at Pet. 24, 30, and *Westinghouse Electric Corp.* v. *Hanovia Chem. & Mfg. Co.*, 179 F. 2d 293, 296-297 (3 Cir. 1949), cited at Pet. 24.

tional issues need not be discussed by us because those issues do not arise on the facts here.*

As to the petition's alleged "conflict" between the Court of Appeals opinion below and the opinion in *Englehard Industries, Inc.* v. *Research Instrumental Corp.*, 324 F. 2d 347 (9 Cir. 1963) this too disappears when the facts here are correctly viewed, even apart from (a) the fact that the court in *Englehard* held non-infringement on another ground, and (b) the fact that the *Englehard* decision was not "on the same matter" as the present case, since that case involved an entirely different patent.**

In *Englehard*, the facts were significantly different from those here. There, after the examiner had made an interpretation of the wording of elected claims **the applicant did not acquiesce in that interpretation; if he had, the Court indicated he would later have been estopped to argue a different interpretation** (Ibid.). Instead, the applicant "broadened" the language of his claims in new claims, "both specific **and generic**", with which he replaced the old. Also, the non-elected species did not correspond precisely to the accused device.

Petitioners argue (Pet. 13-15) that procedural Patent Office requirements, such as requirements for election of species, cannot give rise to a file wrapper estoppel; they say "substantive" rejections are required. Here, of course, Henriksen's cancellation of his generic and "greasy" claims followed a clearly "substantive" rejection on the prior art, so petitioner's argument is inapposite. But that

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* Some of the cases so cited are inapposite, in any event, to civil cases such as patent infringement actions. See e.g., *Levy Leasing Co.* v. *Siegel*, 258 U. S. 242, 250 (1922), *Mahler* v. *Eby*, 264 U. S. 32, 41 (1934) and *Fahey* v. *Mallance*, 332 U. S. 245, 250 (1946), all distinguishing *United States* v. *Cohen Grocery Co.*, 255 U. S. 81, 91 (1921), cited at Pet. 28.

** This Court's Rule 19(1)(b) refers to conflicts between decisions of Courts of Appeals "on the same matter." See *Keller* v. *Adams-Campbell Co.*, 264 U.S. 314, 319 (1924).

argument is also wrong, in reason and logic, and there are cases to the contrary. See e.g., *Higgin Mfg. Co.* v. *Watson*, 263 Fed. 378 (6 Cir. 1920), *Carter Products, Inc.* v. *Colgate-Palmolive Company*, 269 F. 2d 299 (4 Cir. 1959), *Macbeth* v. *Gillinder*, 54 Fed. 169 (C. C. E. D. Pa. 1889), *Speakman Company* v. *Sloan Valve Company*, 166 F. Supp. 877 (E. D. Pa. 1958).

It has also been a long-established rule that Henriksen's last minute remarks about "grease", unaccompanied by any broadening of the wording of claims previously restricted to the different "pulpy" species, cannot affect his prior disclaimer of greasy followers. See e.g., *Thomas* v. *Rocker Spring Co.*, 77 Fed. 420, 431-2 (6 Cir. 1896), cert. denied 168 U. S. 709 (1897), *Johnson Furnace & Engineering Co.* v. *Western Furnace Co.*, 178 Fed. 819, 824 (8 Cir. 1910), *Parke, Davis & Co.* v. *American Cyanamid Co.*, 207 F. 2d 571, 574 (6 Cir. 1953).

Henriksen was, indeed, "his own lexicographer" (Pet. 21). He distinguished "pulpy mass" and "greasy substance" followers, cancelled a claim to the latter and limited his claims to the former in order to get them allowed, and acquiesced in the issuance of his patent with all claims so restricted. The Court of Appeals correctly held that the "pulpy mass" of the patent claims cannot be interpreted to include a "greasy substance".

CONCLUSION.

The petition should be denied.

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